

REMARKS/ARGUMENTS

Applicant's undersigned counsel extends thanks to Examiner Flores-Sánchez for the courtesy of a telephone interview on Monday, June 5, 2006. During the telephone interview, a draft Amendment document was discussed. This Amendment document incorporates the issues and changes discussed during the interview, as noted below.

In the pending Office Action, claims 34-38 were allowed, and claims 6, 19, and 57 were objected to but indicated as allowable if rewritten into independent form. The indication of allowable subject matter is appreciated. Claims 6, 19, and 57 have been rewritten into independent form, including the limitations of base claims as indicated by the Examiner, and are also in condition for allowance. The claims dependent therefrom are also allowable. Therefore, claims 34-38 and claims 6, 7, 19, and 57 are allowed or are allowable per the Office Action.

With respect to the restriction requirement, claims 10-16, 30-33, 39-41, 45-50, and 60-72 have been withdrawn from further consideration. The remaining claims currently pending were rejected as being anticipated by a patent to Gaffney or Lluch, or as being obvious in view of a combination including Gaffney and one or more other cited patent publications. With this amendment, claims 42-44 have been canceled from this application. The remaining independent claims (comprising claims 1, 17, 51, 73, 79) have been amended in view of the Examiner's comments during the telephone interview and are patentable over the cited art. Further examination and reconsideration of the amended claims is requested, and allowance of all pending claims is solicited.

With respect to numbering of the claims, the Second Preliminary Amendment that accompanied the Petition to Make Special filed November 25, 2005 corrected an inadvertent error in which two consecutive claims were numbered "75" (the second "75" was renumbered to "83"). In the pending Office Action of March 21, 2006, however, the Examiner noted the error, which was introduced in the July 2005 first preliminary amendment, and renumbered the claims from the second "75" to the last as 76-83. This renumbering contradicted the renumbering from the Second Preliminary Amendment. In this Response document, Applicants have adopted the

Examiner's renumbering of the claims. The claim dependencies have been renumbered by the present amendment, where necessary.

Rejections Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1, 2, 3, 5, 7, 8, 73-83, 51, 53, 54, 56, and 58 as being anticipated by Gaffney (U.S. Pat. No. 3,517,871). Gaffney describes two embodiments of a pill splitter, a first embodiment (Figs. 1-4) and a second embodiment (Figs. 5-8). In the first embodiment, the pill splitter has a cover element 22 with two foam rubber pads 31, 32 that are located along side surfaces of a cutting blade 21 and are compressible (col. 2, lines 50-60). When the cover element is closed, a pill will push against the foam rubber pads so that the pill itself moves the foam rubber pads away from the blade, for cutting (col. 2, lines 62-69). In the second embodiment, the pill splitter has a cover 52 with a plunger 54 connected to a blade 51 that is withdrawn into a recess 57 in the cover by a spring 58. Pushing on the plunger 54 moves the blade 51 vertically out from the recess 57 and into a pill (col. 3, lines 24-34). Thus, a deliberate application of force to the plunger is necessary to expose the blade. It is submitted that neither embodiment anticipates the pending claims.

As discussed in the telephone interview, Gaffney does not show a retractable blade guard that is engaged with the lid so that movement of the lid alone is directly translated into movement of the blade guard (this phrasing has been added by the present amendment). In Gaffney, neither the foam rubber pads 31, 32 nor the lid recess 57 engage the lid such that "movement of the lid alone is directly translated into movement of the blade guard," as recited in the amended claim 1. In both embodiments of Gaffney, movement of the lid does not directly translate to movement of the blade guard. In fact, movement of the lid alone will not cause the blade guard to move at all. For Gaffney's first embodiment, the pill itself moves the foam rubber pads, and for Gaffney's second embodiment, movement of the plunger moves the blade out from the recess (i.e., the blade guard itself does not move). In both cases, the lid of Gaffney can be moved with no responsive movement of the blade guard at all. As agreed upon with the Examiner, this operation of Gaffney cannot constitute movement of the lid alone directly translated to movement of the blade guard.

Claim 1, as amended, reads:

1. (currently amended) A pill box comprising:
a base having a pill cutting surface;
a lid connected to the base, the lid having a blade; and
a retractable blade guard engaging the lid such that movement of
the lid alone is directly translated into movement of the blade guard.

It should be noted that the claim, as originally filed, included a limitation that the blade guard is secured to the base. Further review of Gaffney and the cited art indicates that this limitation is not necessary for patentability, and therefore this phrasing has been removed by the present amendment. As noted during the telephone interview with the examiner, the movement of the lid alone being directly translated into movement of the blade guard is sufficient for patentability.

Thus, Gaffney is missing the limitation of a retractable blade guard engaging the lid such that movement of the lid alone is directly translated into movement of the blade guard, and therefore Gaffney does not anticipate Claim 1. Gaffney also cannot anticipate any of the claims dependent therefrom. Claims 17, 51, and 73, all independent claims, also have been amended so they contain similar limitations to claim 1^{*}. Thus, claims 17, 51, and 73 all recite the lid is configured such that movement of the lid alone is directly translated into movement of the blade guard. None of these claims are anticipated by Gaffney. Claim 79 (an independent claim) has been amended to recite that the guard moves in direct response to movement of the lid alone, and therefore Claim 79 also is distinguished over Gaffney.

Therefore, it is submitted that the amended independent claims and the claims dependent therefrom, comprising Claims 1, 2, 3, 5, 7, 8, 73-83, 51, 53, 54, 56, and 58, are not anticipated by Gaffney.

Claims 42-44 were rejected as anticipated by Lluich. These claims have been cancelled, so that their rejection is rendered moot.

^{*} Similarly, the "secured to the base" language has been deleted from these claims

Rejections Under 35 U.S.C. § 103

The remaining claims were rejected over Gaffney and one or more other patent publications. Claims 4, 21, and 55 were rejected over Gaffney and the patent to Reitano (U.S. Patent No. 6,474,525); Claims 9 and 59 were rejected over Gaffney and the application to Dienst (U.S. Publication No. 2003/0019900); Claims 17, 18, 20, 22, and 28 were rejected over Gaffney and the patent to Buckley (U.S. Patent No. 6,601,746); Claims 23, 24 were rejected over Gaffney and Buckley and Reitano; Claims 25-27 were rejected over Gaffney and Buckley and Bendickson (U.S. Patent No. 4,825,552); Claim 29 was rejected over Gaffney, Buckley, Bendickson, and Dienst; Claim 52 was rejected over Gaffney and Stevens (U.S. Patent No. 3,815,802). Claim 44 was rejected over Lluch and Gaffney, but this claim has been canceled, rendering its rejection moot.

None of the patents cited against the pending claims can make up for the deficiencies of Gaffney. The cited patents were asserted for sub-structures that do not make up for the deficiencies of Gaffney, and include devices that either are pill splitters with no blade guard or are not even pill splitters. Therefore, the proposed combinations, even if successfully combined and even if suggested by the art, would not provide all the claimed features. Thus, the rejected claims are not rendered obvious by the proposed combinations.

The cited references to Reitano, Dienst, Buckley, Bendickson, and Stevens (as well as Lluch) do not include blade guards or are not even pill splitters. Therefore, none of them can possibly make up for the deficiencies of Gaffney in that none of them can provide a blade guard that moves in response to movement of the lid or the blade itself. Thus, Claims 4, 9, 17, 18, 20, 21, 22, 23, 24, 25-27, 28, 29, 52, 55, and 59 are not rendered obvious by the art of record, but are in condition for allowance.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance, in addition to claims 34-38 and claims 6, 7, 19, and 57 previously indicated as containing allowable subject matter. The allowable claims therefore

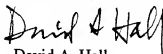
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are submitted to comprise claims 1-9, 17-29, 34-38, 51-59, 73-83. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a further telephone conference would expedite prosecution of this application, please telephone the undersigned at 858-350-6100.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "David A. Hall". The signature is written in a cursive, slightly slanted style.

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